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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/854,084

05/10/2001

Tongwei Liu

10013649-1

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04/24/2006

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

P.O. Box 272400

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EXAMINER

BROWN JR, NATHAN H

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |   |                                   |  |
|------------------------------|---|-----------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/854,084    | <b>Applicant(s)</b><br>LIU ET AL. |  |
|                              | <b>Examiner</b><br>Nathan H. Brown, Jr. | <b>Art Unit</b><br>2121           |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-24 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## Examiner's Detailed Office Action

1. This Office is responsive to the communication for application 09/854,084, filed September, 12, 2005.
2. Claims 1-24 have been examined.

## Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are considered to be directed to an algorithm or software or a computer program that does not meet the standard set forth in the State Street Bank case of being tangible, useful, and concrete. In this instance the claims are not considered to be tangible since no real world result is provided. A "computer implemented method for action selection" does not produce a real world result that is tangible and concrete, i.e., the mere selection of an action does not make it or any consequents extant.

## Response to Arguments

4. Applicant's argument filed September, 12, 2005, with respect to 101 rejection for claim 1, has been fully considered but is not persuasive. The invention embodiment set forth in claim 1 may produce a practical application (selecting actions), but it does not produce a tangible real-world results as the selection is a state of the computation of the invention embodiment.

5. Applicant's arguments, see communication for application 09/854,084, filed September, 12, 2005, with respect to 101 rejections for claims 9-16 and claims 17-24, have been fully considered and are persuasive. Claims 9-16 and 17-24 claim a machine and an article of manufacture, respectively, and are thus statutory. The 101 rejection of claims 9-16 and 17-24 has been withdrawn.

6. Applicant's arguments, see communication for application 09/854,084, filed September, 12, 2005, with respect to 103 rejections, have been fully considered and are persuasive. The 103 rejection of claims 1, 3-9, 11-17, and 19-24 has been withdrawn.

## Reasons For Allowance

7. Claims 9-16 and 17-24 are allowed.

8. The following is an examiner's statement of reasons for allowance: Applicant's arguments, see communication for application 09/854,084, filed September, 12, 2005, with respect to 101 and 103 rejections for claims 9-16 and 17-24, have been fully considered and are persuasive.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### Conclusion

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### Correspondence Information

Art Unit: 2121

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan H. Brown, Jr. whose telephone number is 571-272- 8632. The examiner can normally be reached on M-F 0830-1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 571-272-3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Knight  
Supervisory Patent Examiner  
Tech Center 2100

Nathan H. Brown, Jr.  
April 13, 2006